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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/691,718

10/22/2003

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Tatta-3

6848

32132 7590 08/05/2009  
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EXAMINER

CHAN, KO HUNG

ART UNIT

PAPER NUMBER

3632

MAIL DATE

DELIVERY MODE

08/05/2009

PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* ANDREW TATTA

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Appeal 2009-001147  
Application 10/691,718  
Technology Center 3600

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Decided: August 5, 2009

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Before LINDA E. HORNER, STEVEN D.A. McCARTHY  
and STEFAN STAICOVICI, *Administrative Patent Judges*.

McCARTHY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellant appeals under 35 U.S.C. § 134 (2002) from the Examiner's decision finally rejecting claims 1, 3, 8, 9, 13 and 15 under 35 U.S.C. § 103(a) (2002) as being unpatentable over Friedman (US 6,127,938, issued Oct. 3, 2000) and Kassab (US 6,258,200 B1, issued Jul. 10, 2001); finally rejecting claims 2, 6 and 11 under § 103(a) as being unpatentable over Friedman, Kassab and Konsti (US 5,688,579, issued Nov. 18, 1997); finally rejecting claim 4 under § 103(a) as being unpatentable over Friedman, Kassab and Burnette (US 4,848,542, issued Jul. 18, 1989); finally rejecting claims 7 and 12 under § 103(a) as being unpatentable over Friedman, Kassab, Konsti and Burnette; and finally rejecting claim 14 under § 103(a) as being unpatentable over Friedman, Kassab and Domenig (US 5,152,593, issued Oct. 6, 1992). The Examiner indicates the subject matter of dependent claim 5 to be allowable if the claim is rewritten. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

We AFFIRM.

Claim 1 is typical of the claims on appeal:

1. A mounting device for mounting an electronic toll payment pass to the interior of a contoured windshield and diminishing the visibility of the electronic toll pass through the windshield, said device comprising:
  - a flexible support substrate having a face surface and a back surface, said flexible support substrate being conformable to the interior of the contoured windshield;
  - a display image covering said face surface of said flexible support substrate;

an adhesive coating on at least a part of said display image, wherein said adhesive coating enables said display image to be selectively attached directly to the contoured windshield of the vehicle as said flexible support substrate conforms to the contoured windshield; and

at least one fastener coupled to said back surface of said flexible support substrate that enables the electronic toll payment pass to be selectively mounted to said back surface of said flexible support substrate.

## ISSUES

The Examiner finds that Friedman discloses a flexible support substrate in the form of the backing strip of a piece of hook material for making a hook-and-loop connection. (Ans. 3.) The Examiner further finds that Kassab discloses a conventional windshield sticker including an indicia-bearing substrate and a transparent adhesive layer for contact with a vehicle windshield. (Ans. 4.) The Examiner concludes that it would have been obvious “to have provided [a] display image to the substrate of Friedman such that information can be displayed through the windshield and to adhesively attach the substrate as taught by the Prior Art disclosed by Kassab.” (*Id.*)

In contesting the rejections of claims 1 and 9, the Appellant contends that the Examiner has not provided a motivation to combine the teachings of Friedman and Kassab. (Br. 11-12.) The Appellant also contends that Friedman and Kassab together would not have disclosed or suggested a device for holding a toll payment pass designed to diminish the visibility of the pass without affecting the pass' operation. (Br. 7 and 8.) Finally, the Appellant contends that Friedman and Kassab together would not have

1 provided one of ordinary skill in the art reason to use either a thin, flexible  
2 substrate on which a display image is printed, or an adhesive to attach the  
3 thin, flexible substrate to a windshield, in a device for holding a toll payment  
4 pass. (*Id.*)

5 The Appellant argues the rejections of claims 2, 6, and 11; claim 4;  
6 claims 7 and 12; and claim 14 under separate subheadings. Nevertheless,  
7 the Appellant's contentions with respect to the rejections of each of these  
8 dependent claims are limited to the argument that the tertiary references  
9 cited against the claims do not overcome the perceived deficiencies of  
10 Friedman and Kassab. (Br. 8-11.)

11 This appeal turns on one issue:

12 Has the Appellant shown that the Examiner erred by  
13 failing to articulate reasoning with some rational underpinning  
14 sufficient to support the conclusion that Friedman and Kassab  
15 would have provided one of ordinary skill in the art reason to  
16 include in a toll payment pass holder a thin, flexible substrate  
17 on which a display image is printed and an adhesive for  
18 attaching the thin, flexible substrate to a windshield?

19  
20 FINDINGS OF FACT

21 The record supports the following findings of fact ("FF") by a  
22 preponderance of the evidence.

23 1. Friedman teaches that it was known to mount securement  
24 elements 14 to the windshield W of a vehicle V to support an electronic toll  
25 payment pass 10. (Friedman, col. 3, l. 66 – col. 4, l. 2.)

2. Figures 2 and 5 of Friedman depict the securement elements *14* as hook materials for forming hook-and-loop fastenings.

3. More specifically, Figures 2 and 5 of Friedman depict the securement elements *14* as including thin, opaque support substrates and fasteners in the form of plastic hooks coupled to back surfaces of the substrates.

4. Figures 2-4 of Friedman depict the thin support substrates of the securement elements *14* as being attached flush to the windshield *W*. This implies that the thin support substrates have sufficient flexibility to conform to the interior of a contoured windshield

5. Friedman discloses a holder *20* for an electronic toll payment pass. (Friedman, col. 4, ll. 2-5.) Friedman's holder *20* includes a main housing member *22* and a slidable drawer member *24*. (Friedman, col. 4, ll. 5-6.) Friedman's main housing member *22* has securement elements *36* for complementary engagement with the securement elements *14* to support the main housing member *22* and the slidable drawer *24* on the windshield *W*. (Friedman, col. 4, ll. 21-23.)

6. Friedman's slidable drawer *24* has securement elements *34* for complementary engagement with securement elements *12* on the electronic toll payment pass *10*. (Friedman, col. 4, ll. 16-18.)

7. Friedman's entire holder *20* is attached to the windshield *W* by means of the securement elements *14*. The electronic toll payment pass *10* is selectively mounted to the back surfaces of the thin, flexible support substrates of the securement elements *14* through the mediation of the securement elements *36*; the main housing member *22*; the slidable drawer *24*; and the securement elements *34*. Figures 2 and 3 of Friedman depict the

1 securement elements *14* as being interposed between the windshield *W* and  
2 the electronic toll payment pass *10*.

3 8. Figure 5 of Friedman depicts the main housing member *22* as  
4 being opaque, at least to the extent that the securement elements *36* cannot  
5 be seen through a front panel of the main housing member *22*. As a  
6 consequence, the mounting device, including the securement elements *14*  
7 and the main housing member *22*, diminishes the visibility of the electronic  
8 toll pass *10* through the windshield *W* in the sense that the device conceals  
9 the electronic toll payment pass *10* from view through the windshield *W*  
10 when the slidable drawer *24* is positioned behind the main housing member  
11 *22*.

12 9. Kassab discloses that it was known to mount a windshield  
13 sticker *14*, including an indicia-bearing substrate *16*, on an inside surface of  
14 a windshield *12* of a vehicle *10*, so that the indicia on the substrate *16* might  
15 be viewed from outside the vehicle *10*. (Kassab, col. 5, ll. 35-37, 40-42 and  
16 45-47.)

17 10. Kassab discloses mounting the windshield sticker *14* on the  
18 inside surface of the windshield *12* with a layer *18* of transparent adhesive.  
19 (Kassab, col. 4, ll. 36-37 and 42-47.)

20 11. The structure of a windshield sticker is similar to the structure  
21 of the substrate of a hook material for forming a hook-and-loop fastening.  
22 Both a windshield sticker and the substrate of a hook material are thin,  
23 flexible sheets capable of conforming to the contour of a windshield.

1 PRINCIPLES OF LAW

2 “[I]f a technique has been used to improve one device, and a person of  
3 ordinary skill in the art would recognize that it would improve similar  
4 devices in the same way, using the techniques is obvious unless its  
5 application is beyond his or her skill.” *KSR Int’l Co. v. Teleflex, Inc.*, 550  
6 U.S. 398, 417 (2007). Likewise, “the application of a known technique to a  
7 piece of prior art ready for the improvement” would have been obvious  
8 unless the improvement would have been beyond the level of ordinary skill  
9 in the art or the success of the improvement could not reasonably have been  
10 predicted by one of ordinary skill in the art. *Id.*

11  
12 ANALYSIS

13 With respect to claim 1, Friedman discloses a mounting device for  
14 mounting an electronic toll payment pass to the interior of a contoured  
15 windshield. (FF 5.) Friedman’s mounting device diminishes the visibility  
16 of the electronic toll pass through the windshield. (FF 8.) Friedman’s  
17 mounting device comprises (that is, includes) a flexible support substrate,  
18 namely, the substrate of one of the securement elements 14. (FF 1-4.) The  
19 flexible support substrate is conformable to the interior of the contoured  
20 windshield. (*Id.*) Friedman’s mounting device also comprises fasteners, that  
21 is, hooks, coupled to a back surface of the flexible support substrate. (FF 3.)  
22 These fasteners enable the electronic toll payment pass to be selectively  
23 mounted to the back surface of the flexible support substrate. (FF 7.)

24 With respect to claim 9, Friedman’s disclosure implies a method of  
25 mounting an electronic toll payment pass to a contoured windshield of a  
26 vehicle in the sense that Friedman’s mounting device is designed for use in



1 carrying out such a method. When Friedman's mounting device is used in a  
2 method of mounting an electronic toll payment pass to a contoured  
3 windshield of a vehicle, the visibility of the electronic toll pass through the  
4 contoured windshield is diminished. (*See* FF 8.) The mounting device itself  
5 provides a flexible support substrate. (FF 1-4.) The entire mounting  
6 structure or device is attached to the contoured windshield through the  
7 flexible support substrate. (*See* FF 7.) The flexible support substrate has a  
8 front surface which abuts against the contoured windshield so that the  
9 substrate conforms to the contoured windshield. (*Id.*) In use, the electronic  
10 toll payment pass is attached to the back surface of the flexible support  
11 substrate such that the flexible support substrate is interposed between the  
12 contoured windshield and the electronic toll payment pass. (*Id.*)

13 Friedman does not disclose how the flexible support substrates, that is,  
14 the substrates of the securement elements 14, are mounted on the  
15 windshield. Kassab discloses adhering a windshield sticker to a windshield  
16 by means of a layer of transparent adhesive. (FF 10.) Since a windshield  
17 sticker and the support substrates of hook materials, such as the securement  
18 elements 14 of Friedman, are similar in configuration, flexibility and  
19 conformability to the contours of windshields (FF 11), one of ordinary skill  
20 in the art would have had reason to improve Friedman's securement  
21 elements 14 by bonding them to a windshield in the same manner that  
22 Kassab describes bonding windshield stickers, namely, by a layer of  
23 transparent adhesive.

24 Friedman does not disclose including a display image on the surface  
25 of one of the support substrates of the securement elements 14 visible from  
26 outside the vehicle when the securement elements 14 are bonded to the

1 windshield. Nevertheless, it would have been apparent to one of ordinary  
2 skill in the art without reference to the Appellant's Specification that the  
3 unadorned front surface of the substrate, covered by a transparent but  
4 refractive layer of adhesive, might be viewed as unsightly. Kassab describes  
5 including indicia on a surface of a windshield sticker visible outside a  
6 vehicle. (FF 9.) The unsightly surfaces of Friedman's securement elements  
7 *14*, visible through the windshield, would have been ripe for improvement  
8 by adding indicia to personalize or otherwise decorate the surfaces with  
9 display images. The nature of the indicia is material to the patentability of  
10 the claims on appeal: Claims 1 and 9 recite neither the nature of the display  
11 image nor any functional relationship between the display image and any  
12 recited element or step.

13 By these improvements, Friedman's securement elements *14* would  
14 have met the limitations of representative claims 1 and 9. The Appellant  
15 presents no persuasive argument or evidence demonstrating that these  
16 improvements would have been beyond the level of ordinary skill in the art.  
17 Neither has the Appellant presented any persuasive argument or evidence  
18 demonstrating that one of ordinary skill in the art could not have reasonably  
19 predicted their success in providing an operative but less unsightly mounting  
20 for an electronic toll payment pass.

## 21 22 CONCLUSIONS

23 The Appellant has not shown that the Examiner erred by failing to  
24 articulate reasoning with some rational underpinning sufficient to support  
25 the conclusion that Friedman and Kassab would have provided one of  
26 ordinary skill in the art reason to include in a toll payment pass holder a thin,

1 flexible substrate on which a display image is printed and an adhesive for  
2 attaching the thin, flexible substrate to a windshield. Therefore, the  
3 Appellant has not shown that the Examiner erred in rejecting either  
4 independent claims 1 and 9 or dependent claims 3, 8, 13 and 15 under  
5 § 103(a) as being unpatentable over Friedman and Kassab.

6 The Appellant's contentions with respect to the rejections of  
7 dependent claims 2, 6, and 11; dependent claim 4; dependent claims 7 and  
8 12; and dependent claim 14 are limited to the argument that the tertiary  
9 references cited against the claims do not overcome perceived deficiencies  
10 of Friedman and Kassab. Since the Appellant has not shown any such  
11 deficiencies, the Appellant has not shown that the Examiner erred in  
12 rejecting claims 2, 6 and 11 under § 103(a) as being unpatentable over  
13 Friedman, Kassab and Konsti; in rejecting claim 4 under § 103(a) as being  
14 unpatentable over Friedman, Kassab and Burnette; in rejecting claims 7 and  
15 12 under § 103(a) as being unpatentable over Friedman, Kassab, Konsti and  
16 Burnette; and in rejecting claim 14 under § 103(a) as being unpatentable  
17 over Friedman, Kassab and Domenig.

18  
19 DECISION

20 We AFFIRM the Examiner's decision rejecting claims 1-4, 6-9 and  
21 11-15.

22 No time period for taking any subsequent action in connection with  
23 this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R.  
24 § 1.136(a)(1)(iv) (2007).

25  
26 AFFIRMED

Appeal 2009-001147  
Application 10/691,718

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